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09/593,573	06/14/2000	Olivier Casile	YOR9-1999-0577-US1	7644

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EXAMINER

SHANG, ANNAN Q

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/593,573

Applicant(s)

CASILE ET AL.

Examiner

Annan Q. Shang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim(s) 30 define a "signal" *modulated/encoded/embodied on a carrier wave/etc. (Insertion Note: whatever is claimed)* with functional descriptive material. While functional descriptive material may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium, a "signal" per se does not fall within any of the four statutory classes of 35 U.S.C. §101. A "signal" is not a process because it is not a series of steps per se. Furthermore, a "signal" is not a "machine", "composition of matter" or a "manufacture" because these statutory classes "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." (1 D. Chisum, Patents § 1.02 (1994)). Machines, manufactures and compositions of matter are embodied by physical structures or material, whereas a "signal" has neither a physical structure nor a tangible material. That is, a "signal" is not a "machine" because it has no physical structure, and does not perform any useful, concrete and tangible result. Likewise, a "signal" is not a "composition of matter" because it is not "matter", but rather a form of energy. Finally, a "signal" is not a "manufacture" because all traditional definitions of a "manufacture" have required some form of physical structure, which a claimed signal does not have.

A "manufacture" is defined as "the production of articles for use from raw materials or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." Diamond

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v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931).

Therefore, a “signal” is considered non-statutory because it is a form of energy, in the absence of any physical structure or tangible material, that does not fall within any of the four statutory classes of 35 U.S.C. §101.

NOTE: Refer to Annex IV, section (c) of the USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, Official Gazette notice of 22 November 2005 (currently at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 12-13, 16-17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by **Fries (6,317,885)**.

As to claim 1, note the **Fries** reference figures 1-3 and 10-12, discloses an interactive entertainment and information system using TV STB and further discloses a

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method for providing secondary content related to primary content in a broadcast stream comprising the steps of:

Obtaining (Head end 'HE' 22) secondary content which relates to the main primary content (col.4, lines 4-55); An authoring station for creating a schedule (Carousel Server 46) for delivery of the secondary data content in a predetermined relation to the non-cyclic broadcasting of the primary content; and Cyclically delivering (Carousel Server 46) the secondary content based on the schedule and comprises content for use by an interactive TV application and provides control information with the secondary content (figs.2 10-12, col.8, line 13-25, col.9, line 33-col.10, line 46, col.11, line 59-col.12, line 58, col.13, line 59-col.15, line 32, col.19, line 30-col.20, line 22).

As to claim 2, Fries further discloses creating a schedule for the first delivery of the secondary content prior to delivery of the primary content and at least one successive delivery of the secondary content after commencement of delivery of the primary content (col.11, line 59-col.12, line 58, col.13, line 59-col.15, line 32, col.19, line 30-col.20, line 22).

As to claims 3-10, Fries further discloses dynamically modifying the schedule by adjusting the schedule based on the viewer's interaction, receiving at least one viewer request for retransmission and rebroadcasting of the Web content and responds to the at least one viewer request, selectively transmitting the request to the viewer, generating the request based on a poll of viewers requests and interactions, counting the number of viewer requests for retransmission of the secondary content and where

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the rebroadcasting is conducted upon receipt of a threshold number of viewer requests for retransmission and where the responding to at least one viewer request comprises narrowcasting the secondary content (col.4, lines 4-28, col.8, lines 13-25, col.11, line 59-col.12, line 58, col.13, line 58-col.15, line 21, col.22, line 52-col.23, line 3 and col.33, line 19-col.34, line 36).

As to claim 11, Fries further discloses displaying notification data for notifying the viewer of the delivering of secondary content (col.15, lines 22-32 and col.33, line 19-col.34, line 36).

As to claim 12, Fries further discloses the transport mechanism for the primary content is analog TV broadcast stream and the transport mechanism for the secondary content comprises VBI within the analog TV broadcast stream (col.3, lines 22-65).

As to claim 12, Fries further discloses where the transport mechanism for the MPEG TV content is a digital television broadcast stream, and the transport mechanism for the secondary data is additional data stream within the digital television broadcast stream (col.3, lines 22-65, col.13, line 59-col.15, line 32, and col.33, line 19-col.34, line 36).

Claims 14-16 are met as previously discussed with respect to claim 1.

As to claim 17, Fries further discloses where providing control information comprises including at least one unique identifier for the secondary data, an identification of the MPEG TV content to which the Web content pertains, scheduling information for future broadcasting of the secondary data, timing information regarding

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relating the GUI data to the MPEG TV content (col.3, lines 22-65, col.13, line 59-col.15, line 32, and col.33, line 19-col.34, line 36).

Claim 18 is met as previously discussed with respect to claims 3-10.

As to claim 19, the claimed "a system for providing secondary content related to a primary content..." is composed of the same structural element that were discussed in the rejection of claim 1.

Claim 20 is met as previously discussed with respect to claims 3-10.

As to claims 21 and 22, Fries further discloses where transmitting over telephone channel and over coaxial cable (col.3, lines 2-65 and col.33, line 19-col.34, line 36)

As to claim 23, Fries further discloses where transmitting over a wireless return channel (col.3, lines 36-41).

As to claim 24, note the **Fries** reference figure 3, discloses an apparatus for providing display of primary content and secondary content related to the primary content which is broadcast from a broadcast location comprising:

A receiving component (see fig.3, input/70/71) for receiving an input stream from the broadcast location, Head end 'HE' 22 (col.5, line 9-50);

A processing component (88/89/90/92/52/94) for identifying cyclic secondary content in the input stream and for handling the secondary content (col.5, line 37-col.6, line 15);

At least one buffer location for receiving the secondary content of the input stream from the processing component and for buffering the secondary content (col.5, line 9-50 and col.33, line 56-col.34, line 36); and

A display component (82/96/98) for displaying the primary content from the input stream and for receiving the secondary content from the at least one buffer location and displaying the secondary content; where the processing component comprises means for extracting control information from the input stream and for handling the secondary content based on the control information (col.5, line 37-col.6, line 55 and col.33, line 56-col.34, line 36).

Claim 26 is met as previously discussed with respect to claims 3-10.

As to claim 30, the claimed "A broadcast stream..." is composed of the same structural element that were discussed in the rejection of claim 1.

Response to Arguments

4. Applicant's arguments with respect to claims 1-24, 26 and 30 have been considered but are moot in view of the new ground(s) of rejection discussed above. This office action is non-final.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Klosterman et al (6,078,348) disclose TV schedule system with enhanced features.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', written over a rectangular box.

Annan Q. Shang